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23573	7590	07/06/2004	EXAMINER	
HOLLAND & KNIGHT, LLP ONE EAST BROWARD BLVD. SUITE 1300 FT LAUDERDALE, FL 33301			CARTER, MONICA SMITH	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/817,826
Filing Date: March 26, 2001
Appellant(s): FOX-LOVELL, SHEILA D.

MAILED

JUL 06 2004

GROUP 3700

Donald S. Showalter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 12, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claim 1 has been cancelled in favor of claim 15.

Non-elected claims 12, 13 and 14 have been withdrawn from consideration.

Independent claim 15 and dependent claims 2 through 11, inclusive, are pending. All stand finally rejected under 35 U.S.C. 103(a) as unpatentable over Baldwin '904 in view of Jackson '090 pursuant to the Office action mailed February 13, 2004.

In response to Appellant's Appeal Brief filed November 14, 2003, the Examiner re-opened prosecution by Office action mailed February 13, 2004. That Office action included citation of ten (10) new references including Baldwin '904. Claims 15 and 2 through 11, inclusive, were rejected under 35 U.S.C. 103(a) as unpatentable over Baldwin '904 in view of Jackson '090.

The Office action of February 13, 2004 withdrew the final 103(a) rejection over the combination of Jackson '090 in view of Blank '482. A response to the arguments made in Appellant's Appeal Brief of November 14, 2003 were moot in view of the new

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grounds of rejection (as indicated in the Office action mailed February 13, 2004 in paragraph 4).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The only pending issue is whether the examiner erred in rejecting claims 15 and 2-11 under 35 U.S.C. 103(a) as being unpatentable over Baldwin '904 in view of Jackson '090 (appellant's stated issue number "2"). As discussed above, the rejection relying on Jackson '090 in view of Blank '482 (appellant's state issue number "1") was withdrawn in a previous Office action.

(7) Grouping of Claims

ALL STAND OR FALL TOGETHER

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,907,904	BALDWIN	3-1990
5,795,090	JACKSON	8-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (4,907,904) in view of Jackson ('090).

Regarding claim 15, Baldwin discloses a personal information system for maintaining information comprising at least one first substrate (20) locatable at a first location (the first location being the pocket (18) releasably retaining the board (20)); a plurality of registration labels (25) detachably adhered to the first substrate (see col. 2, lines 25-34 and 59-66), each of the labels are either blank or have first indicia (27) preprinted thereon (see col. 1, lines 36-45), each of the labels further having at least one field within which the information is to be entered in writing by the customer (see col. 1, lines 46-52); when the first substrate is removed from the pocket, the substrate is located sufficiently accessible to the customer to permit the customer to view the labels detachably adhered to the first substrate and to enter the information in the field of one of the labels while the one of the labels remains detachably adhered to the first substrate; and a registration log (as seen in figure 1) having at least one second substrate (30), the second substrate having a plurality of label-retaining spaces (30') and a series of second indicia (31), each one of the spaces including an area to which the respective corresponding one of the labels may be adhered after the information has been entered in writing in the field by the customer and the corresponding one of

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the labels has been detached from the first substrate so that the labels adhered to the second substrate provide an original record of the writing (see col. 2, lines 56-66), the second substrate being locatable at a second location (the second location being retained by the binding mechanism of the notebook via the apertures in the pages 30) at a time when the first substrate is located at the first location (as seen in figure 1), the second location being a location at which the entered information on any of the labels adhered to the second substrate is out of view of the customer when the first substrate is removed from the pocket and maintained in a location remote from the notebook.

Baldwin discloses the claimed invention except for the specific arrangement and/or content of indicia (the first indicia identifying the position of each of the labels in an uninterrupted sequence and the second indicia corresponding to the first indicia to associate each one of the spaces with a respective corresponding one of the labels according to the sequence) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia for the first and second indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of personal information system does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional

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relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Furthermore, Jackson discloses a log book (10) comprising a first substrate (12) locatable at a first location; a plurality of labels (i.e., 14A) detachably adhered to the first substrate, each of the labels having one of a series of first indicia (14AA) identifying the position of each of the labels in an uninterrupted sequence. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Baldwin's invention to include indicia identifying the position of each of the labels in an uninterrupted sequence, as taught by Jackson, to properly align the labels with the label retaining spaces in chronological order.

Regarding claim 2, Baldwin, as modified by Jackson, discloses the registration log including more than one second substrate (see col. 2, lines 18-24 – “pages 30”). Regarding each second substrate including third indicia to identify a sequential order of the second substrates in the registration log, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia for the second substrates since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a

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specific type of substrate does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 3, Baldwin, as modified by Jackson, discloses a designated area for a user to enter information (see col. 1, lines 36-45 – blank labels would enable the user to enter any desired information; to include a date on which services were provided to the customer).

Regarding claim 4, Baldwin, as modified by Jackson, discloses the label-retaining spaces having indicia (31)(see col. 2, lines 22-24). Presuming, arguendo, that applicant does not consider the indicia of Baldwin to be text, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include instructions on how to attach the labels in the label-retaining spaces of the second substrates, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of second substrate does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel

and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 5, see the above rejections to claim 15.

Regarding claim 6, see the above rejections to claim 15.

Regarding claim 7, Baldwin, as modified by Jackson, discloses the first substrate including a first surface and a mutually opposed second surface and the plurality of labels being adhered only to the first surface (as seen in figure 1).

Regarding claim 8, Baldwin, as modified by Jackson, discloses the second substrate including a first surface and a mutually opposed second surface and the plurality of label-retaining spaces being disposed on both the first and second surfaces (see col. 2, lines 18-22).

Regarding claim 9, Baldwin, as modified by Jackson, discloses the first indicia comprising a numeral and a letter of the alphabet (see Jackson, figure 1).

Regarding claim 10, see the above rejections to claim 15 regarding indicia.

Regarding claim 11, Baldwin, as modified by Jackson, discloses the registration log being a spiral bound book (as seen in figure 1 of Jackson).

(11) *Response to Argument*

The Rejection over Baldwin '904 in view of Jackson '090 is Improper.

- a) The Examiner Has Again Improperly Failed To Give Weight to Expressly Recited
Printed Matter

Applicant disagrees with the examiner's conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate.

In the present invention, the claimed customer registration system improves the protection of the confidentiality of information provided by a customer at the time of registration. The system includes a first substrate having detachably adhered labels having first indicia identifying the position of that label in an uninterrupted sequence. The first substrate is located in a first location to be accessible to customers. The labels may be removed from the first substrate. The system further includes a second substrate having label-retaining spaces, each of which is identified by one of a series of second indicia. The second indicia correspond with the first indicia so as to associate each one of the label retaining spaces with a respective corresponding one of the labels.

The examiner maintains that the claimed printed matter merely comprises printed matter which is supported by a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the personal information system of Baldwin comprising a first substrate 20 having detachable labels 25 with indicia 27 and a second substrate 30 having label-retaining spaces 30' with corresponding indicia 31 for receiving the labels is the same structure claimed by applicant and the sole difference is

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in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Furthermore, it is noted that Baldwin discloses the second indicia 31 on the second substrate 30 "facilitate orderly attachment and replacement of labels 25." (see column 1, lines 46-52 and column 2, lines 22-24). The second indicia, therefore, correspond with the first indicia on the first substrate to identify the proper position of each label so that each label can be placed in a specifically designated location on the second substrate.

Regarding the labels having indicia identifying the position of each of the labels in an uninterrupted sequence, Jackson discloses a log book 10 having a first substrate 12 with a plurality of detachable labels (e.g., 14A) adhered to the first substrate, wherein each of the labels have a series of first indicia (14AA) identifying the position of each of the labels in an uninterrupted sequence (e.g., "A1" on the first label, "A2" on the second label, "A3" on the third label, etc.).

b) The Postulated Combination of Baldwin '904 and Jackson '090 Lacks Significant
 Elements of Claim 15

Appellant argues that Jackson fails to disclose "second indicia" on a "second substrate" to "associate each of said label retaining spaces with a respective corresponding one of said labels according to said sequence."

It is noted that the Jackson reference has been relied upon for further disclosing a substrate 12 having detachable labels (e.g., 14A), wherein the labels include indicia (14AA) identifying the position of each of the labels in an uninterrupted sequence (e.g., "A1" on the first label, "A2" on the second label, "A3" on the third label, etc.) and has not been relied upon for disclosing associating the label retaining spaces of a second substrate with the labels.

c) Baldwin '904 and Jackson '090 Are Non-Analogous Art Whose Combination Lacks Prior Art Motivation

Appellant argues that neither Baldwin nor Jackson recognize the problem of protecting the confidentiality of information entered by a customer when registering at a place of business much less, suggest a solution to that problem along the lines of the claimed invention.

While neither Baldwin nor Jackson specifically set forth appellant's intended use, appellant's invention as presently claimed does not distinguish over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the structure of Baldwin in view of Jackson is capable of

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performing the intended use of protecting the confidentiality of information entered by a customer when registering at a place of business, since the labels on the first substrate of Baldwin can be removed from the first substrate and then placed in the label-retaining spaces of the second substrate. The first substrate is removably inserted into a pocket of the notebook and when removed from the notebook, the first substrate is made accessible to the customer while remaining at a location remote from the second substrate. Therefore, the labels that are retained in the label-retaining spaces on the second substrate can be kept in a second, confidential location remote from the first location.

Furthermore, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

d) Additional Arguments Regarding 2/13/04 Rejections Of Dependent Claims 3 and 4

Regarding claim 3, appellant argues that the combination of Baldwin and Jackson fail to suggest an area "designate" for entry of the specific information recited in that claim. Appellant further states that a teaching of providing a place (14AC) to enter the date a particular photograph is taken as taught by Jackson does not suggest providing an area designated for entry of the date services are rendered to a customer.

It is noted that the examiner has not relied upon Jackson for disclosing an area “designated” for entry of the specific information. Baldwin discloses the second substrate 30 including an area designated for the user of the system to enter indicia 31, wherein the “designated” area is the surface of the second substrate that receives the indicia. The indicia to be entered would, inherently, include the entry of a date on which services were provided to the customer, since, as stated above, the printed matter is not functionally related to the substrate itself and it would have been obvious to one having ordinary skill in the art at the time of the invention to provide any required printed matter on the second substrate.

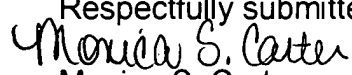
Regarding claim 4, appellant argues that neither Baldwin nor Jackson disclose “instructions to attach said labels in said label retaining spaces.”

The examiner continues to maintain that it would have been obvious to one having ordinary skill in the art to provide the text associated with the label-retaining spaces in the form of instructions, since, as stated above, the printed matter is not functionally related to the substrate itself and it would have been obvious to one having ordinary skill in the art at the time of the invention to provide any required printed matter on the second substrate. Furthermore, Baldwin discloses that the label-retaining spaces 30' are provided with indicia 31 “to facilitate orderly attachment and replacement of labels 25.” The facilitation of the labels in the label-retaining spaces would, inherently, be provided in the form of some type of instruction and/or guideline that provide the user with information to properly place the labels in the label-retaining spaces.

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Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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July 1, 2004

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